UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: G. Weeks *Art Unit:* 3721

In re:

Applicant: Harald KRONDORFER

Serial No.: 09/774,847

Filed: January 31, 2001

BRIEF ON APPEAL

March 21, 2006

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia

Sir:

This is an Appeal from final rejection of claims 11, 14-17, 19-21 and 24-26.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
On 3/23/06

Real Party of Interest

The real party of interest is DAUB, having a business address of Goldbacher Str. 60, D-88662 Überlingen, Germany.

Related Appeals and Interferences

There are no other pending appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

The present application contains claims 11-26.

Claims 12, 13, and 18 are withdrawn from consideration.

Claim 23 is allowed, and claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 11, 14-17, 19-21 and 24-26 are rejected.

Status of Amendments

The last Office Action in this application was the Final Office Action dated November 1, 2005. No Amendments have been filed subsequent to the Final Office Action.

Summary of Claimed Subject Matter

The invention disclosed in the present application deals with a hand power tool having a housing 60. At least one handle is provided as identified with reference numerals 10, 26, 50, 62. The handle has at least one gripping part 12, 72, and a mounting part 16, 70.

The hand power tool is provided further with at least one elastic vibration damping element 14, 24, 52. The elastic vibration damping element is mounted on the mounting part 16, 70. In turn, the at least one gripping part 12, 72 is mounted on the housing through the elastic element 14, 24, 52 and through the mounting part 16, 70.

At least one safety element 20, 22, 28, 64 is further provided and arranged so that the gripping part 12, 72 of the handle is connected with the mounting part 16, 70 of the handle through the safety element 20, 22, 28, 64. The safety element 20, 22, 28, 64 is formed as a rigid component movable during a predetermined operation relative to the

gripping part 12, 72 of the handle in at least a tilting direction and a longitudinal direction, to avoid a passage of vibrations through the safety element 20, 22, 28, 64.

This is essentially disclosed on pages 9-14 of the specification and shown in Figures 1-6 of the drawings.

Grounds of Rejection to be Reviewed on Appeal

In the Final Office Action the Examiner rejected claims 11, 14-17, 19, 20, 22, and 25 under 35 U.S.C. 102(b) as being anticipated by the U.S. patent to Johansson, et al. Thus, the first issue is whether the above specified claims can be considered as being anticipated by the reference cited by the Examiner.

Claims 24 and 25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is therefore another issue on appeal whether claims 24 and 25 are rejectable under 35 U.S.C. 112.

Argument

Claim 11 defines that a hand power tool which has a housing 60, at least one handle 10, 26, 50, 62 having at least one gripping part 12, 72 and the mounting part 16, 70, and at least one elastic, vibration damping element 14, 24, 52. The latter mounted on the mounting part 16, 70. The at least one gripping part 20, 72 is mounted on the housing 60 through the elastic element 14, 24, 52 and also through the mounting part 16, 70.

Claim 11 further defines that at least one safety element 20, 22, 28, 64 is provided and arranged so that the gripping part 12, 72 is connected with the mounting part 16, 70 through the safety element 20, 22, 28, 64. The safety element 20, 22, 28, 64 is formed as a rigid component which is movable during a predetermined operation relative to the gripping part 12, 72 in at least a tilting direction and a longitudinal direction to avoid a passage of vibrations through the safety element 20, 22, 28, 64.

It is respectfully submitted that the new features of the present invention which are defined in claim 11 are not disclosed in the patent to Johanson.

Claim 11 defines that "said at least one gripping part being mounted on said housing through said elastic element and through said mounting part". The patent to Johanson discloses a gripping part 19, an elastic element 35, a mounting part (shown on page 4 in the drawing in the Office Action), and a pusher rod 40 which in the Examiner's opinion is a safety element. The gripping part 19 is mounted on the housing 11 through a bolt 32.

It is therefore believed to be clear that the above mentioned new features of the present invention as defined in claim 11 is not disclosed in the patent to Johanson. In the patent to Johanson the gripping part 19 is supported turnably around the bolt 32 and is pressable by an operator against the elastic element 35 downwardly. The elastic element 35 is located in a cavity of the gripping part 19 and in a cavity of the mounting parts without being connected to them. The elastic element 35 therefore can not mount the gripping part 19 on the housing. This also would be superfluous since the gripping part is already mounted by the bolt 32 of the housing.

The expression "being mounted on said housing through said elastic element and through said mounting part" in the sense of the applicant's invention means that the gripping part 19 is mounted on the

housing through the elastic element and the mounting part, or in other words is fixedly held on the housing through these both parts. In the patent to Johanson, the gripping part, the elastic element and the mounting part are located near one another, however, they are not mounted with one another, so that the gripping part is not mounted on the housing through the parts. Thus, the patent to Johanson does not disclose these new features of the present invention.

Claim 11 also contains the feature that the hand power tool is provided with a safety element which is movable as a rigid component. The Examiner identified the safety element with the pusher rod 40. In the patent to Johanson the push rod 40 however is not a safety element, since through this push rod no safety is provided. The push rod 40 transmits a pressure from the pivot lever 36 to an inlet valve 38, so that by actuation of the pivot lever 36 a pressure air can flow through the inlet valve 38. The push rod 40 therefore provides an operation which has nothing to do with a safety function. The push rod 40 therefore can not be considered to be a safety element.

Therefore it is believed that this feature of claim 11 is also not disclosed in the patent to Johanson.

Furthermore, claim 11 further defines that "at least one safety element through which said gripping part is connected with said mounting part". In the patent to Johanson the gripping part 19 is not connected through the push rod 40 with the mounting part. First of all, the push rod 40 is supported freely and movably in the mounting part so that no connection takes place, and secondly the push rod is supported in the gripping part 19 without contact since otherwise no free movement of the push rod 40 in the longitudinal direction and in the tilting direction relative to the gripping part 19 is possible. Since the push rod 40 has no contact with the gripping part 19, the gripping part 19 is not connected with the push rod 40 and therefore can not be connected through the push rod 40 with the mounting part.

This feature defined in claim 11 is also not disclosed in the patent to Johanson.

In accordance with the present invention, the gripping part is held by the safety element, namely when the elastic element breaks. This means that at least when the elastic element breaks, in accordance with the present invention, the connection of the gripping part through the safety element with the mounting part is provided, since the gripping part is held on the mounting part through the safety element. This is not the

case in the patent to Johanson. In the reference no matter whether it stays or breaks, the gripping part 19 is not held by the push rod 40 and can not be held by it and also can not be connected with it.

It is therefore believed to be clear that the new features of the present invention which are defined in claim 11, are not disclosed in the patent to Johanson.

The Examiner rejected the claims over the patent to Johanson as being anticipated. In connection with this, it is believed to be advisable to cite the decision in re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) it is stated:

> "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Johanson does not disclose each and every element of the present invention as now defined in claim 11, and therefore the anticipation rejection by the Examiner should be reversed, and claim 11 should be allowed.

As for the dependent claims, these claims depend on claim 11, they share its presumably allowable features, and therefore they should be

allowed as well. This is how, in the appellant's opinion, the first issue on the appeal should be resolved.

The Examiner indicated that in his rejection of claims 24 and 25 under 35 U.S.C. 112, that the limitation "not loaded" in line 5 on claim 4 was unclear. Appellants have to respectfully disagree with this position. The feature "unloaded" defines a technical feature which is of a structural nature. In a device there can be loaded elements and unloaded elements, which are clearly distinguishable from one another. It can be easily determined structurally whether an element is loaded or unloaded (not-loaded) for example by simple measurements. Therefore, the expression that the present invention is provided with the not loaded movable safety element represents a structural limitation of the hand power tool. Claim 24 should be considered clear in this sense.

The Examiner further rejected claim 25 under 35 U.S.C. 112 since in his opinion the phrase "safety element which is redundant and functionless" renders the claim indefinite because it is unclear that it constitutes a part of the claimed invention. Appellants disagree with this Examiner's opinion also. In a device there are elements which during the normal operation must not be loaded, so that for an emergency they are available unspent and unlocked. For a person skilled in the art it is clear that the safety element

during a normal operation must not perform any function, so that in the emergency case it can be operational with the greatest possible safety. This is clearly expressed in the last feature of claim 25 in which the connection between the gripping part and the housing through the safety element is mentioned, and it is mentioned that this connection must be maintained in the emergency case, when the elastic element breaks. Claim 25 should be also considered as clear.

In the appellants opinion this is how the second issue on appeal should be resolved, namely by withdrawing of the Examiner's rejection of claims 24 and 25 under 35 U.S.C. 112.

It is respectfully requested to reverse the Examiner's rejection of the claims and to allow the present application.

Respectfully submitted,

Michael J. Striker
Reg. No. 27233
103 East Neck Road
Huntington, NY 11743
(631)549-4700

RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by accord or the board in any proceedings pursuant to paragraph "Related Appeals and Interferences" of the Brief on Appeal".

CLAIMS APPENDIX

Claims 1-10 cancelled.

11. A hand power tool, comprising a housing; at least one handle having at least one gripping part and a mounting part; at least one elastic, vibration damping element mounted on said mounting part, said at least one gripping part being mounted on said housing through said elastic element and through said mounting part; and at least one safety element through which said gripping part is connected with said mounting part, said safety element being formed as a rigid component movable during a predetermined operation relative to said gripping part in at least a tilting direction and a longitudinal direction to avoid a passage of vibrations through the safety element.

14. A hand power tool as defined in claim 11, wherein said safety element is formed as a rigid component which is connected through said elastic element with said gripping part and said mounting part.

15. A hand power tool as defined in claim 11, wherein said elastic element surrounds said safety element.

16. A hand power tool as defined in claim 14, wherein said safety element is arranged in said elastic element along a central axis.

17. A hand power tool as defined in claim 11, wherein said safety element in a mounted condition is loaded by pulling, and said elastic element in a mounted condition is loaded by pressure.

19. A hand power tool as defined in claim 11, wherein said safety element determines a maximum deviation of said elastic element from a base position in a tilting direction.

20. A hand power tool as defined in claim 11, wherein said safety element is connected to said gripping part exclusively via said elastic vibration damping element.

21. A hand power tool as defined in claim 11, wherein said safety element is formed by a rigid rod which is completely surrounded at all sides by said elastic vibration damping element.

24. A hand power tool, comprising a housing; a at least one handle having at least one gripping part; at least one elastic, vibration damping element; a mounting part mounted on said elastic element; said

gripping part being held on said housing by said elastic element and said mounting part; and at least one movable safety element which is not loaded during predetermined operation and by which said gripping part is held on said housing in case of a breakage of the elastic element.

25. A hand power tool, comprising a housing; a at least one handle having at least one gripping part; at least one elastic, vibration damping element; a mounting part mounted on said elastic element; said gripping part being held on said housing by said elastic element and said mounting part; and at least one movable safety element which is arranged so that it is redundant and functionless during normal operation and by which said gripping part is held on said housing in case of a breakage of the elastic element.

26. A hand power tool, comprising a housing; at least one handle having at least one gripping part and a mounting part; at least one elastic, vibration damping element mounted on said mounting part, said at least one gripping part being mounted on said housing through said elastic element and through said mounting part; and at least one safety element through which said gripping part is connected with said mounting part, said safety element is formed as a rigid component being movable during a predetermined operation relative to said mounting part in at least a tilting

direction and a longitudinal direction to avoid a passage of vibrations through the safety element.

EVIDENCE APPENDIX

None